

REMARKS

Claims 1-20 were pending at the time of examination. Claims 1-5 and 8-20 have been amended. No new matter has been added. The applicant respectfully requests reconsideration based on the foregoing amendments and these remarks.

Objections to the Claims

Claim 3 was objected to because it recited “creating a Java™ object having a same name as...” and the Examiner suggested that the quoted phrase be changed to “creating a Java™ object having the same name as...” The applicant welcomes the Examiner’s suggestion and has amended claim 3 accordingly.

Claims 1-20 were objected to because they contain abbreviations such as API, JSP, SOAP. The applicant has amended all claims in question to recite Application Program Interface, Java Server Page, and Simple Object Access Protocol, respectively, and submits that the claims do not contain any informalities and that the claim objections be withdrawn.

Objections to the Specification

The specification was objected to because of the use of the trademarks JavaScript™ and Java™ not being capitalized and accompanied by generic terminology. The specification was also objected to for not defining the abbreviations API and HTML. In order to overcome these objections, the applicant has amended paragraph [0001] to clearly indicate the trademarks and include generic language, and provided a definitions of API and HTML, respectively, at their first occurrences. The applicant submits that the amended specification is now in non-objectionable form and respectfully requests that the objections be withdrawn.

Claim Rejections – 35 U.S.C. § 112

Claims 1-20 were rejected under the second paragraph of 35 U.S.C. 112 as being indefinite for including the trademark JavaScript™. The applicant respectfully traverses this rejection. The Examiner is reminded that if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the user of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention (*see, for example, In re Gebauer-Fuelnegg, 121 F.2d 505, 50 USPQ 125 (CCPA 1941)*).

The applicant has capitalized every occurrence of JavaScript™ in the claims, accompanied it by the TM symbol, and added generic language wherever appropriate. Furthermore, it is respectfully submitted that a person of ordinary skill in the art would have no doubts as to what programming language and set of features enabled by that language are referred to by the trademark JavaScript™. Finally, paragraph [0018] of the specification provides further definitions as to the functionality and source of the JavaScript™ programming language. Thus, it is respectfully submitted that claims 1-20 as amended are definite.

Claim 5 was rejected as having insufficient basis for the “wherein the identifying includes identifying...” limitation. The applicant has amended claim 5 to recite “wherein registering includes identifying...” and submits that there is now sufficient antecedent basis for the limitation. Claims 6-8 were rejected since they directly depend on claim 5. Consequently, it is respectfully submitted that claims 6-8 are allowable for the same reasons, and it is respectfully requested that all rejections under 35 U.S.C. 112 be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1 and 4 were rejected under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 7,093,194 B2 to Nelson (hereinafter “Nelson”). The applicant respectfully traverses these rejections.

Claim 1, as amended, recites:

“A process for setting up the execution of a server-side method by a client-side data processing system, comprising:
creating an Application Program Interface on the server side for a server-side software method;
automatically creating a JAVASCRIPT™ interpreted script language program that contains calls to the server-side software method in accordance with the Application Program Interface; and
sending the created JAVASCRIPT™ program to the client side.”

Nelson is directed to “a web-based data access system that allows people to easily access, manipulate and share information” (col.1, lines 35-37), not a “process for setting up the execution of a server-side method by a client-side data processing system,” as recited in the preamble of claim 1. The Examiner acknowledges that the step of “creating an Application Program Interface on the server side for a server-side software method” is not explicitly disclosed in Nelson, but states that it would be “inherent in Nelson (API and TABLE 1)” (Office Action, page 5). The applicant respectfully disagrees. Nelson describes a “cube interface object” having “a number of methods (routines) for manipulating and controlling report object

15 in response to user request received from interface modules” (col. 5, lines 17-20). A “web server 13 directs each user request to the appropriate web pages of interface modules 23, which in turn invoke the corresponding method interfaces provided by cube interface object 24” (col. 5, lines 24-27). That is, the API described in Nelson only contains functionality for manipulating and controlling a report object. The API is not invoked by clients, but instead the clients communicate with a web server in a conventional way, which in turn invokes an interface module 23, which in turn invokes the cube interface object. Claim 1, on the other hand recites that the API is for “a server-side software method” and that the JavaScript™ interpreted script language program, which is sent to the client side, contains calls to the server-side software method in accordance with the API. Thus, it is clear from claim 1 that the API as recited fields calls from the JavaScript™ program on the client. It is respectfully submitted that such an API is neither inherently or explicitly anticipated by Nelson.

Furthermore, claim 1 recites “automatically creating a JAVASCRIPT™ interpreted script language program that contains calls to the server-side software method in accordance with the Application Program Interface.” The Examiner alleges that this too is anticipated by Nelson, and cites a passage that states “converter 27 generates the client-side script” (col. 8, lines 53-54). The applicant respectfully disagrees. The client-side script generated in Nelson is generated in response to a client request for a script for creating a presentation model and is a translation of a report object. When executed on the client, the script builds a client-side presentation model that corresponds to the report object on the server (col. 8, lines 47-53). Respectfully, this does not anticipate the limitation of “automatically creating a JAVASCRIPT™ interpreted script language program that contains calls to the server-side software method in accordance with the Application Program Interface.” For at least these reasons, it is respectfully submitted that the rejection of claim 1 under 35 U.S.C § 102(b) is unsupported by the art and should be withdrawn.

Claim 4 depends directly from claim 1, and contains further limitations which the Examiner could not explicitly find in Nelson. Thus, for at least reasons substantially similar to those set forth above, the applicant respectfully contends that the rejection of claim 4 is unsupported by the cited art and should be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 12-13 and 17-20 were rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson in view of U.S. Patent No. 6,369,821 B1 to Merrill et al. (hereinafter “Merrill”). The applicant respectfully traverses these rejections.

Claim 2 depends directly from claim 1, and is thus neither anticipated nor rendered obvious by Nelson for at least the reasons discussed above. Furthermore, the Examiner acknowledges that Nelson does not disclose executing the script on the client side to call the server-side software method, as recited in claim 2, and relies on “an analogous process” in Merrill to show this.

The applicant generally agrees with the Examiner’s assertion that Merrill shows executing a script on the client side to access a server. However, the process in Merrill is described in terms of a Visual Basic Script and requires that the browser loads an “OLE control representing the character into the process space of the browser” (col. 35, lines 7-8) and that “the browser accesses the animation server...through the control interface” which “acts as a gateway, routing requests for access to the animation server’s methods and properties for a particular character to the animation server” (col. 35, lines 12-16).

In order to establish a *prima facie* case of obviousness, the Examiner must show a motivation to combine Nelson and Merrill. Nothing in Nelson suggests a desire to combine his web-based database report system with the OLE control interface for animation objects in Merrill. Furthermore, the Examiner needs to show a reasonable expectation of success, which the Examiner has failed to do since he has not shown how Merrill would work in combination with Nelson without the OLE control interface. Finally, the combination of the references must teach or suggest all the claim limitations. Even if it were possible to combine Nelson and Merrill, the combination still would not teach the limitation of “executing the JAVASCRIPT™ program on the client side to call the server-side software method” as recited in claim 2. For at least these reasons, the rejection of claim 2 is unsupported by the art and should be withdrawn.

Claims 12-13 depend directly from claim 2. Thus, for reasons substantially similar to those set forth above, the applicant respectfully contends that the rejection of claims 12-13 is unsupported by the cited art and should be withdrawn.

Claim 17 recites similar distinguishing features to claim 2, and claims 18-20 depend directly from claim 17. Thus, for reasons substantially similar to those set forth above, the applicant respectfully contends that the rejection of claims 17-20 is unsupported by the cited art and should be withdrawn.

Claims 3 was rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson in view of Merrill and in further view of U.S. Patent No. 6,549,955 B2 to Guthrie et al. (hereinafter “Guthrie”). The applicant respectfully traverses these rejections. Claim 3 depends directly from claim 2, and is thus neither anticipated nor rendered obvious by the Nelson and Merrill combination for at least the reasons discussed above. The Examiner acknowledges that Nelson

and Merrill, alone or in combination, do not disclose “executing the JAVASCRIPT™ program includes creating a JAVA™ programming language object having the same name as a server-side JAVA™ programming language bean,” as recited in claim 3, and relies on and “analogous process” in Guthrie for this showing. Guthrie describes “a software system for dynamic generation of remote proxy classes at runtime through a distributed object management system” (Abstract). While Guthrie may describe a system where the proxy objects have the same name as the corresponding server objects, Guthrie does not add any further features that renders claim 2 any more obvious than the Nelson/Merrill combination. Since claim 3 depends directly from claim 2, the applicant respectfully contends that the rejection of claim 3 is unsupported by the cited art and should be withdrawn for at least the reasons discussed above with respect to claim 2.

Claims 5 and 7-8 were rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson in view of U.S. Patent Publication No. 2003/0218633 A1 to Mikhail et al. (hereinafter “Mikhail”). The applicant respectfully traverses these rejections. Claim 5 depends directly from claim 1, and is thus neither anticipated nor rendered obvious for at least the reasons discussed above with respect to claim 1. The Examiner acknowledges that Nelson does not disclose “identifying the registered server-side methods,” as recited by claim 5, and relies on an analogous process in Mikhail for this showing. However, the cited passage of Mikhail describes “*specifying a callback method* for the desired notification.” This is not the same as *identifying the registered server-side methods*, as described in claim 5. Thus, for at least these reasons, and the reasons discussed above with respect to claim 1, it is respectfully submitted that claim 5 is neither anticipated nor rendered obvious by the cited art and that the rejection be withdrawn.

Claims 7-8 depend directly from claim 5. Thus, for reasons substantially similar to those set forth above, the applicant respectfully contends that the rejection of claims 7-8 is unsupported by the cited art and should be withdrawn.

Claim 6 was rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson and Mikhail as applied to claim 5, and further in view of U.S. Patent No. 6,836,889 B1 to Chan et al. (hereinafter “Chan”). The applicant respectfully traverses these rejections. Claim 6 depends directly from claim 5, and is thus neither anticipated nor rendered obvious by the Nelson and Michail combination for at least the reasons discussed above with respect to claim 5. Furthermore, Chan is an improper reference to apply under 35 U.S.C § 103(a), since it only qualifies under 35 U.S.C § 102(e) and both Chan and the present invention were subject to an obligation of assignment to International Business Machines Corporation at the time of the

invention. Thus, for at least these reasons, it is respectfully submitted that claim 6 is neither anticipated nor rendered obvious by the cited art and that the rejection be withdrawn.

Claims 9-11 were rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson in view of U.S. Patent No. 7,043,732 B2 to Mandal et al. (hereinafter "Mandal"). The applicant respectfully traverses these rejections. Claims 9-11 depends from claim 1 and are, for reasons substantially similar to those set forth above, not anticipated or rendered obvious by the cited art. The applicant respectfully requests that the rejection of claims 9-11 under 35 U.S.C § 103(a) be withdrawn.

Claims 14-16 were rejected under 35 U.S.C § 103(a) as being unpatentable over Nelson and Merrill as applied to claim 2 and further in view of U.S. Patent No. 6,457,066 B1 to Mein et al. (hereinafter "Mein"). The applicant respectfully traverses these rejections. Claims 14-16 depend from claims 2 and 1, respectively, and are for reasons substantially similar to those set forth above with respect to claims 2 and 1, not anticipated or rendered obvious by the cited art. Mein provides a general description of the SOAP protocol, but does not render claims 1 or 2 more obvious than the Nelson/Merrill combination alone. Thus, the applicant respectfully requests that the rejection of dependent claims 14-16 under 35 U.S.C § 103(a) be withdrawn.

Conclusion

The applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. The applicant also petitions for a one-month extension of time which may be required to extend the pendency of this case, and authorizes the Commissioner to withdraw any fees necessary for such an extension from Deposit Account No. 090460. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
MOLLBORN PATENTS



Fredrik Mollborn
Reg. No. 48,587

2840 Colby Drive
Boulder, CO 80305
(303) 459-4527